

Hearing: September 15, 1999

Hanak/Walker

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB MARCH 31, 2000

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re PNC Bank Corp.

Serial No. 74/282,055

Mark S. Sommers for PNC Bank Corp.
Jason Turner, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney)

Before Cissel, Hanak and Chapman, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

PNC Bank Corp. (applicant) seeks to register BANKING
STATION for "interactive multimedia banking services
offered through PNC Bank Corp's kiosks and terminals linked
exclusively to PNC Bank." At the request of the examining
attorney, applicant disclaimed the exclusive right to use
the word BANKING.

The examining attorney has refused registration on two grounds. First, citing Section 2(d) of the Trademark Act, the examining attorney contends that applicant's mark, as applied to applicant's services, is likely to cause confusion with the mark ABN AMRO BANKSTATION, previously registered for "electronic banking services." Registration No. 1,755,684. Second, citing Section 2(e)(1) of the Trademark Act, the examining attorney contends that applicant's mark is merely descriptive of applicant's services.

Both applicant and the examining attorney filed briefs and were present at a hearing on September 15, 1999.

We consider first whether there is a likelihood of confusion resulting from the contemporaneous use of applicant's mark BANKING STATION and the registered mark ABN AMRO BANKSTATION. We find that the two marks are dissimilar enough that even if we assume that both were used on identical banking services, there would be no likelihood of confusion. Obviously, the component of the registered mark which is similar to applicant's mark BANKING STATION is the final word, namely, BANKSTATION. As applied to banking services, both BANKING STATION and BANKSTATION are, at minimum, clearly suggestive. Indeed, it is the

contention of the examining attorney that applicant's mark BANKING STATION is not only suggestive, but indeed is merely descriptive. Our primary reviewing Court has repeatedly held that if the only term common to two marks is clearly suggestive, a likelihood of confusion is rarely found. Tektronix, Inc. v Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694 (CCPA 1976). Moreover, our primary reviewing Court has held that when consumers select banking services, they exercise a high level of care such that "it would be strange for the customers of the banks to be confused about whom they are dealing with." Amalgamated Bank v. Amalgamated Trust, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988). Thus, given the dissimilarities in the two marks with the common portion being clearly suggestive, and given the fact that in selecting banking services customers exercise a high level of care, we find there is no likelihood of confusion resulting from the contemporaneous use of applicant's mark and registrant's mark.

We turn now to the question of whether applicant's mark is merely descriptive of applicant's services. As has been stated repeatedly, "a term is merely descriptive if forthwith conveys an immediate idea of the ingredients,

qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

In support of the refusal to register applicant's mark on the basis that it is merely descriptive of applicant's services, the examining attorney relies simply upon 26 stories retrieved from the NEXIS database wherein the term "banking station(s)" appeared. However, four of these NEXIS references are wire service stories or stories from foreign publications, evidence which this Board does not recognize in determining whether a word or term is primarily merely descriptive. Of the remaining 22 stories, over half (twelve) make specific reference to applicant's BANKING STATION services. Thus, these twelve stories do not support the examining attorney's position that BANKING STATION is merely descriptive. Rather, they support the applicant's position that the term BANKING STATION refers

to applicant. In the vast majority of these twelve stories (namely, ten), the term BANKING STATION is depicted in a proper service mark manner with the initial letters in both words capitalized. In two of the twelve stories referring specifically to applicant's BANKING STATION services, the term BANKING STATION is depicted in all lower case letters. Finally, in reviewing the remaining ten stories wherein the term "banking station(s)" is not used to refer to applicant's services, we simply note that said term is almost always preceded by an adjective such as "sit-down"; "drive-up"; "personal"; "video"; "electronic"; "automated"; or "computerized."

Thus, the examining attorney's sole evidence that BANKING STATION is merely descriptive of applicant's services consists of ten stories retrieved from the extremely vast NEXIS database. Moreover, these ten stories use the term "banking station(s)" with various adjectives such that it is clear that the term has significantly different meanings depending upon which story is reviewed. Thus, when used in connection with banking services, the term "banking station(s)" -- standing alone -- fails to forthwith convey an immediate

idea of the characteristics of the banking services with the required "degree of particularity."

It is common knowledge that banking services are not only a very old category of services, but in addition they are a very widely existing category of services. See Amalgamated Bank, 6 USPQ2d 1305. Given these two facts and the additional fact that the NEXIS database is extremely comprehensive, we find that ten stories are simply not sufficient to demonstrate that applicant's mark BANKING STATION is merely descriptive, especially when these ten stories use the term "banking station(s)" in manners such that it has no particular meaning.

Finally, we would be remiss if we did not note that the contention that applicant's mark was merely descriptive of its services was not raised until late in this proceeding. Indeed, for three years it was the position of the PTO that not only was applicant's mark BANKING STATION not merely descriptive, but indeed applicant's mark was, as applied to banking services, "incongruous." (Examining Attorney's brief dated January 20, 1995 at page five).

Obviously, the PTO changed its position with regard to the purported mere descriptiveness of applicant's mark.

However, the PTO's longstanding, earlier contrary position only further establishes that applicant's mark is not merely descriptive of applicant's services. To elaborate, examining attorneys are trained professionals who, unlike consumers, carefully review marks during the examination process. For the first three years of the life of this application (June 1992 to June 1995), it never occurred to the examining attorney that the mark was descriptive of applicant's services. Indeed, as previously noted, the examining attorney felt that as applied to applicant's services, the mark BANKING STATION was "incongruous." Thus, if applicant's mark did not convey any information about applicant's services to the examining attorney who was carefully reviewing said mark, it is highly unlikely that the mark would "forthwith convey an immediate idea of the ... characteristics" of applicant's services to ordinary banking customers. Abcor, 200 USPQ at 218 (emphasis added).

Decision: The refusals to register under Sections 2(d) and 2(e)(1) of the Trademark Act are reversed.

E. W. Hanak

B. A. Chapman
Administrative Trademark Judges

Trademark Trial and Appeal Board

Cissel, Administrative Trademark Judge, dissenting:

While I agree with my colleagues that the refusal to register based on Section 2(d) of the Act should be reversed, I respectfully disagree with their conclusion regarding the refusal under Section 2(e)(1).

In my opinion, the Examining Attorney has shown that "BANKING STATION" is merely descriptive of applicant's banking services because it is used, both by applicant and by others, to refer to the places where banking services are provided by means of computer. Indeed, this application was originally filed based on applicant's assertion that it possessed the intent to use the mark for, among other things, computer hardware and software for providing interactive banking services, and freestanding financial service centers comprising booths, wall and ceiling panels and parts therefor.

In support of the refusal based on descriptiveness, the Examining Attorney made of record a dictionary definition of the word "station" as "a computer,

workstation or terminal in a network." The additional evidence in the form of excerpts from stories retrieved from the Nexis® database of publications shows that the term sought to be registered is frequently used in reference to the "workstation" or "terminal" in a booth or kiosk wherein a customer can conduct his or her banking. Typical examples follow: "... besides a branch with extended hours inside the store, it built three drive-up banking stations outside the supermarket"; "the lower-level of the structure also served as the main office's drive-up banking station"; "for example, a small bank in Illinois recently replaced its teller counters with sit-down banking stations."; "The BE-6500 can be customized to meet the needs of individual banking stations through the use of up to 18 keys..."; and "The system includes 65 banking stations and 10 processing units."

The fact that some of the examples cited by the Examining Attorney precede the descriptive term in question with different adjectives does not mandate a different conclusion. In each situation, the term refers to the place where computerized banking services are available. Although, as the majority points out, some of the excerpts retrieved by the Examining Attorney show use of the term in reference to applicant's services, the term is no less

descriptive of the banking services in those excerpts, as it still refers to the place or location where the services are available.

As the majority also points out, in two of those stories the term sought to be registered is even presented in lower case letters, which is totally inconsistent with finding that the term is a registrable trademark, although whether or not capital letters are used is not critical to this determination.

In summary, the evidence submitted by the Examining Attorney establishes that the term is merely descriptive because it immediately conveys, with particularity, a specific characteristic or feature of the services, namely the location where they are available.

Contrary to the majority, I am not troubled by the quantity of the evidence submitted by the Examining Attorney showing descriptive use of this term. The evidence is clear to me, and it is consistent with the ordinary meanings one would attribute to the combination of the two words which make up the term. Indeed, the descriptiveness of the term is the central reason for reversing the refusal to register under Section 2(d) of the Act. Whether or not banking services are "a widely

existing category of services," as the majority puts it, is irrelevant to my analysis of this case.

Nor does the timing of the refusal based on descriptiveness pose a problem. In fact, this case had proceeded all the way to an oral hearing before the Board in 1995 before it became apparent that the issue of descriptiveness had not been previously raised. At that juncture, action on the appeal was suspended and the application was remanded to the Examining Attorney for further examination, whereupon the refusal on the ground of descriptiveness was made. In my view, this action was completely consistent with proper Office practice and procedure. I therefore disagree with the conclusion of the majority that "[o]bviously, the PTO changed its position with regard to the purported mere descriptiveness of applicant's mark." Nor can I agree with the conclusion of the majority that the Office had taken a "longstanding, earlier contrary position." Responsive to the first brief applicant filed, when the issue was limited to whether confusion was likely in view of the cited registered mark, the Examining Attorney specifically commented that in view of the fact that there was no evidence that either the registered mark or applicant's mark was being used in commerce at all, the record did not support finding that

either the registered mark or applicant's mark were either descriptive or generic in connection with banking services. This argument was made to undercut applicant's argument that confusion was not likely because the registered mark contains the designations "ABN" and "AMRO" in addition to "BANKSTATION." From my perspective, this comment in the responsive appeal brief filed by the Examining Attorney falls far short of establishing that the PTO had "for years" taken this position that the term sought to be registered was not merely descriptive. The PTO did not obviously change its position. The issue had never been raised.

I cannot understand why my colleagues view the delay in refusing registration based on descriptiveness as somehow establishing that the mark is not merely descriptive of applicant's services.

For the reasons set forth above, while I would reverse the refusal to register under Section 2(d), I would affirm the refusal to register under Section 2(e)(1).

R. F. Cissel
Administrative Trademark Judge,
Trademark Trial & Appeal Board

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